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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,827	10/11/2001	Mitsuyuki Hatanaka	450100-03538	2274

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NEW YORK, NY 10151

EXAMINER

GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,827

Applicant(s)

HATANAKA ET AL.

Examiner

Tom Gyorfi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-4 remain for examination. The correspondence filed 3/29/05 amended claims 1, 3, and 4.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/29/05 has been entered.

Response to Arguments

3. Applicant's arguments, see the Request for Continued Examination filed 3/29/05, with respect to the rejection(s) of claim(s) 1-4 under 35 USC 103 in view of Ichimura and Tagawa have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ichimura and Epstein.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (U.S. Patent 6,034,832) and further in view of Epstein (U.S. Patent 6,601,046).

Referring to Claims 1, 3 and 4:

Ichimura discloses an information processing apparatus having functions for recording contents recorded on a first recording medium onto a second recording medium, said apparatus comprising: recording means for recording said contents recorded on said first recording medium onto said second recording medium (col 2, lines 5-20);

recording history information storing means for storing information regarding said contents as recording history information at the time of said contents recorded on said first recording medium being recorded onto said second recording medium by said recording means (col. 2, lines 15-30; col. 11, lines 5-10; col. 13, lines 20-35); and

display means for searching for information regarding said contents stored as recording history information by said recording history information storing means at the time of said contents recorded on said first recording medium being recorded onto said second recording medium again by said recording means (col. 22, lines 45-60) and displaying said information (col. 8, lines 1-5).

Ichimura does not disclose "checking in means for rendering unusable said contents recorded onto said second medium from said first recording medium", nor recording history information "at the time of said contents recorded onto said second

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recording medium being rendered unusable, wherein said recording history information includes a check-out number which is decremented when said recording means records said contents on said first recording medium onto said second recording medium and is incremented when said checking in means renders unusable said contents recorded onto said second recording medium from said first recording medium.”

Epstein discloses checking in means for rendering unusable said contents recorded onto said second medium from said first recording medium (col. 2, lines 22-39); recording history information at the time of said contents recorded onto said second recording medium being rendered unusable (col. 4, lines 5-26) wherein said recording history information includes a check-out number which is decremented when said recording means records said contents on said first recording medium onto said second recording medium (col. 3, line 45 – col. 4, line 4) and is incremented when said checking in means renders unusable said contents recorded onto said second recording medium from said first recording medium (col. 4, lines 5-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a check-out mechanism similar to that disclosed by Epstein as part of the recording history information disclosed by Ichimura. The motivation for doing so would be to balance the copyrights of the owner of intellectual property with the fair-use rights of the purchasers, for example by minimizing the damage caused by a loss of a copy (Epstein: col. 2, lines 13-21).

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Referring to Claim 2.

Ichimura and Epstein disclose the limitations of Claim 1 above. Ichimura further discloses said recording history information contains audio recording history information which records the number of times that audio recording has been made for each track of said first recording medium, title saving information of said contents, and play list information (col. 5, line 60-col 6, line 15; col. 8, lines 25-50).

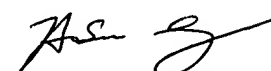
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:00am - 4:30pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAG – 6/20/05


Primary Examiner
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